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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,092	07/20/2001	Gregory Bret Turetzky	SIRF.107USU1	2442

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THE ECLIPSE GROUP
10453 RAINTREE LANE
NORTHRIDGE, CA 91326

EXAMINER

CONTEE, JOY KIMBERLY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,092

Applicant(s)

TURETZKY

Examiner

Joy K Contee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 10, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 10, 2004 have been fully considered but they are not persuasive.

Applicant argues that the double patenting rejections of claims 1-20 in the instant application are moot because a disclaimer will not disclaim any time, since the patents (US 6,529,829;US 6,680,695;US 6,466,161) and copending application (09/090,716) have an effective filing date, the same as the instant application.

However, Examiner has maintained the obvious-type double patenting rejections intended to prevent prolongation of the patent term by prohibiting claims they maybe granted in a later issued patent not patentably distinguishing from claims in a first patent.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,529,829 ('829), in view of Soliman et al. (Soliman), gpsOne™ : A hybrid position location system, Qualcomm, Inc., © 2000.

Regarding claims 1-11 of the instant application states --a CDMA receiver, comprising: a first data path for correlating an incoming CDMA signal, located within a scanned signal window, with a locally generated signal; a second data path for verifying the incoming CDMA signal, located within the scanned signal window, against a lock signal, the second data path determining whether the incoming CDMA signal has at least one characteristic which differentiates the incoming CDMA signal from an auto-correlated signal or a cross-correlated signal; and means for inputting a second incoming CDMA signal to the first data path if the incoming CDMA signal lacks the at least one characteristic.

In comparison, Claim 1 of '829 claims similar limitations except for a dead reckoning system comprising a GPS receiver, wherein the CDMA signal is a GPS signal and the input is a dead reckoning input, which is analogous to a CDMA signal. In this case dead reckoning refers to location tracking, hence the input CDMA signal is used for the same purpose in the instant application. Thus, '829 claims a dead reckoning system comprising a GPS receiver opposed to instant application's CDMA receiver functioning the same.

In a similar field of endeavor, Soliman provides evidence for GPS and CDMA integration(see abstract, page 330).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the claims 1-20 of the instant application to include the GPS deadreckoning signals in lieu of CDMA input signals since it is known in the art for CDMA signals to encompass GPS signals, i.e., CDMA and GPS hardware can be shared, as taught by Soliman (page 334 #3, lines 12-1 and page 335, #5, lines 33-35).

Further, dependent claims 2-11 are encompassed in claims 1-8 of '829. The differences in the claims are the same as mentioned above, when referring to claim 1 of the instant application.

4. Claims 12-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,529,829 ('829). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-8 of '829 encompass the scope of claims 12-20 of the instant application.

Regarding claims 12-20 of the instant application, claim 12 states --A cellular telephone including a GPS receiver, comprising: a cellular telephone transceiver for transmitting and receiving cellular telephone signals; a Global Positioning System (GPS) receiver, coupled to the cellular telephone transceiver, comprising: a first data path for correlating an incoming GPS signal, located within a scanned signal window, with a locally generated signal; a second data path for verifying the incoming GPS signal, located within the scanned signal window, against a lock signal, the second data

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path determining whether the incoming GPS signal has at least one characteristic which differentiates the incoming GPS signal from an auto-correlated signal and a cross-correlated signal; and a data path executive for monitoring the first data path and, when the incoming GPS signal does not contain the at least one characteristic, for continuing to search the scanned signal window for a second incoming GPS signal. The difference between the independent claims 12 of the instant application and claim 1 of '829 is that '829 claims dead reckoning system and input to the GPS receiver for use in computing a position of the GPS receiver. However, the deadreckoning receiver is analogous to the GPS receiver, in that a second incoming GPS signal is used to determine the position.

Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

5. Claims 12-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,466,161 ('161). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 12-20 encompass the scope of claims 1-8 of '161. The difference between claims 12-20 of instant application and '161 is that '161 claims a location services system, wherein there are means for informing a user of the location services system the position of the GPS receiver, hence the instant application claims a cellular telephone.

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Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

6. Claims 12-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,680,695 ("695). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 12-20 encompass the scope of claims 1-8 of '695. The difference between claims 12-20 of the instant application and '695 is that '695 states that the GPS receiver can change the locally generated signal to continue the search the scanned signal window, thus the data path executive in the instant application is continuing a search for the second incoming GPS signal to change first data path.

Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

7. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/909,716 ('716). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of the instant application encompass the scope of claims 1-20 of '716. The difference between the two sets of claims is that the instant application claims a CDMA

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receiver/GPS receiver, the apparatus, and '716 claims the method for reducing auto-correlation and cross-correlation in a CDMA receiver/GPS receiver.

Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-

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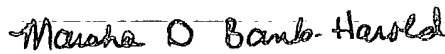
0149. The examiner can normally be reached on M (alternating), T & Th, 5:30 a.m. to 2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joy Contee

October 6, 2004


MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600